Supreme Court, U.S.
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No. 00-565

In The

Supreme Court of the United States

EXPRESS SERVICES, INC.,

Petitioner,

v.

CAREERS EXPRESS STAFFING SERVICES and TAMMY M. FORD d/b/a CAREERS EXPRESS,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Third Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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STATEMENT PURSUANT TO RULE 29.6

Defendants/Appellees, Careers Express Staffing Services and Tammy M. Ford d/b/a Careers Express, respectfully state that neither Defendant/Appellee is a publicly traded entity and that neither Defendant/Appellee has a parent, subsidiary or affiliate which has issued shares to the public.

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STATEMENT OF THE CASE

Express Services, Inc. ("Express"), is a Colorado corporation with its principal place of business in Oklahoma City. Careers Express Staffing Services and Tammy M. Ford d/b/a Careers Express ("Careers") have their principal place of business in King of Prussia, Pennsylvania. Express operates a nationwide franchise system of more than 300 franchisees and provides temporary and permanent employment agency services. Express' first use of the mark "Express Personnel Services" in the Philadelphia area occurred almost simultaneously with Careers' first use of the mark "Careers Express." The Third Circuit held that it was not clear error for the District Court to have determined that Express failed to demonstrate that Careers' use of the name "Careers Express" created a likelihood of confusion, which is required to establish infringement. Pet., App. A at 10a.

The District Court found that Express carries on no business under the single name "express." Pet., App. E at 33a. The District Court also found that all of the businesses of Express use "express" in conjunction with some other word or design. Pet., App. E at 33a. Express offered no evidence to the contrary at trial. Furthermore, the District Court found that Express does business in Pennsylvania exclusively as "Express Personnel Services." Pet., App. E at 33a. This finding of fact was not challenged by Express in either of its appeals to the United States Court of Appeals for the Third Circuit or its Petition for Writ of Certiorari from this Court.

The District Court found that advertising specimens submitted by Express to the United States Patent and

Trademark Office ("USPTO") showing only the word "express" as a mark have never been used in commerce. Pet., App. E at 33a. Such a finding raises the issue of whether or not Express is entitled to any of the benefits of the registration of the mark "Express."

Finally, the District Court held that the use of the word "careers" is sufficient to distinguish the two companies' marks in the minds of consumers as representing different entities. Pet., App. E at 39a. Such a finding clearly indicates that even if the term "express" were deemed to be arbitrary or suggestive, Express did not establish that Careers' use of the name "Careers Express" created the likelihood of confusion.

MISSTATEMENTS OF FACT AND LAW CONTAINED IN THE PETITION

Express misstated the nature of its marks by claiming that a crucial part of its success has been its reliance on a family of service marks that permit customers easily to identify the source of the services Express provides. Pet. at 3. There is no evidence in the record to establish such a self-serving claim.

Express also stated that as a result of litigation it was successful by compelling competitors to cease using a wide variety of similar names. Pet. at 4. Such a statement ignores the fact that the companies that changed the names of their businesses did so as a means of avoiding the need to expend time and resources to litigate the claims filed by Express. The District Court found that despite the fact that Express has taken legal action

against twenty-five companies for trademark infringement, most of these disputes have been settled and no court has issued an injunction on the merits of any case prohibiting the use of the Express marks by any other person. Pet., App. E at 33a-34a. Express improperly described the nature of the results of its litigation as "successful."

Express misstated the nature of its advertising by claiming that all of the advertising by its franchisees prominently displayed Express' registered marks. Pet. at 4. The District Court found that advertising specimens submitted by Express to the USPTO showing only the word [sic] "express" as a mark have never been used in commerce. Pet., App. E at 33a.

Express referred to the District Court's original finding that the term "express" is generic descriptive. Pet. at 5. The District Court in its opinion dated November 5, 1999, indicated that such a characterization was simply a typographical error. Pet., App. D at 24a. This issue is moot at this time.

Express also made reference to the Third Circuit's analysis of the characterization of the term "express" to argue that the Third Circuit considered the term to be suggestive. Pet. at 7. First, the Third Circuit did not state that the term "express" is likely to be suggestive. Furthermore, given the fact that this case was remanded subsequent to the entry of the first Third Circuit opinion, the analysis contained in that opinion is not properly before this Court.

Express claimed that the District Court improperly placed the burden of proving the marks' distinctiveness

on Express. Pet. at 7. The District Court properly placed the burden on Express to prove a likelihood of confusion. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). Express was unable to sustain its burden of proof as to the ultimate issue in the case.

Express misstated the nature of the question presented by posing the hypothetical question, "Does the fact of registration provide protection against infringement?" Pet. at 10. Careers respectfully suggest that the ultimate issue in trademark infringement cases is whether or not the plaintiff has satisfied its burden of proof that there is a likelihood of confusion created by the alleged infringer's use of the mark. *Id.*, at 769. Express is implying that the classification of the term "express" as descriptive removes the protections created by its registration with the USPTO. The accurate classification of the term "express" as descriptive does not improperly take anything away from Express.

Express misstated the nature of the Third Circuit's decisions regarding distinctiveness by claiming that the presumption of distinctiveness has no effect whatsoever. Pet. at 17. The presumption of validity, which is not a presumption of distinctiveness, is taken into consideration by the Third Circuit in infringement cases. Regardless of whether or not the term "express" is presumed to be entitled to a classification as arbitrary, fanciful or suggestive, the District Court carefully analyzed the nature of the marks of Express in reaching its decision that despite any arguments by Express to the contrary, the term "express" is descriptive. The District Court found that the commonality of the words "express" and "service" lead to a conclusion that the marks of Express

are weak and entitled to limited protection. Pet., App. E at 38a. Furthermore, the District Court found that the term "express" describes a characteristic of how Express provides its employment services. Pet., App. E at 26a. Express is attempting to have this case reviewed to address an issue that had little or no impact on the decisions in favor of Careers. The term "express" is descriptive, regardless of what presumptions may be attached to its registration.

Express quoted language from a Third Circuit case out of context. Express includes the quotation, "to demonstrate that the [registered] mark is valid and legally protectable, [plaintiff] must demonstrate that it had established secondary meaning." Pet. at 17. Express failed to include the rest of the sentence, which was as follows, "in the [registered] mark as of the year in which [the defendant] began use of the mark." *Commerce Nat. Ins. v. Commerce Ins. Agency*, 214 F.3d 432, 443 (3rd Cir. 2000).

Trademark law helps the holder of a mark by giving the holder the ability to prevent importation of confusingly similar goods, giving constructive notice of ownership, giving incontestable status and granting the holder prima facie evidence of validity and ownership. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 174 (1995). Express indicated that the presumption of distinctiveness is one of the benefits of registration and cited *Qualitex Co.* to support their argument. *Id.*, at 174. However, *Qualitex Co.* listed evidence of validity and ownership, not a presumption of distinctiveness.

Finally, Express argued that if the burden of proof on the issue of distinctiveness is shifted to Careers, the District Court would have been required to find Careers liable for infringement. Pet. at 22. This argument is not plausible because it ignores the indisputable fact that Express has the burden of proof on the issue of likelihood of confusion. *Two Pesos, Inc.*, 505 U.S. at 769.

REASONS WHY THE PETITION SHOULD BE DENIED

The sole question presented by Express is which party bears the burden of proof that a mark is distinctive or not distinctive. The Third Circuit's decision in this case is not in conflict with the decision of any other United States court of appeals as to this issue. Nor is this issue one that needs to be decided by this Honorable Court. The Third Circuit's decision was proper in all respects and Careers respectfully urge this Court to deny the Petition for Writ of Certiorari.

Furthermore, Express failed to include an analysis of the question presented as to the Tenth Circuit, Eleventh Circuit or District of Columbia Circuit in its petition. Pursuant to Rule 14.4 of the Rules of the Supreme Court of the United States, Express' failure to include this analysis prevents this Court from being able to have a ready and adequate understanding of the points requiring possible consideration. Accordingly, this omission alone is sufficient for the Court to deny the petition filed by Express. In addition, this flaw in the petition cannot be remedied in any subsequent filings by Express.

I. THE SPLIT AMONG THE CIRCUITS AS TO THE EFFECT OF THE PRESUMPTIONS CREATED BY REGISTRATION DOES NOT JUSTIFY REVIEW BY THIS COURT.

The District Court found that Express carries on no business under the single name "Express," that all of Express' businesses use "express" in conjunction with some other word or design and that Express does business in Pennsylvania exclusively as "Express Personnel Services." Pet., App. E at 33a. The District Court also found that no imagination, thought or perception is needed to establish a connection between the term "express" and Express' business. Pet., App. D at 27a. Express presented no evidence to contradict the District Court's findings, and the District Court correctly determined, based on an analysis of the appropriate factors, that the word "express" describes a specific quality and characteristic of the employment services provided by Express. Pet., App. D at 27a. Accordingly, even if the District Court was required to apply the additional presumptions to the registration of the marks of Express, said presumptions were clearly rebutted by Careers. Nevertheless, Careers will address some of the various Circuit Court opinions on this issue. Again, Express failed to address three of the twelve Circuit Courts.

1) **First Circuit.** Express failed to present any evidence at trial as to its belief that there are presumptions that the term "express" is not descriptive and that the term "express" has acquired secondary meaning. In fact, Express failed to present any witnesses or survey evidence at trial. Express cannot raise arguments on appeal that it failed to present to the District Court. *Equine*

Technologies, Inc. v. Equitechnology, Inc., 68 F.3d 542, 546 (1st Cir. 1995). Furthermore, the strength of a mark is but one of eight factors (in the First Circuit) to be considered in analyzing the likelihood of confusion issue. *Id.*

The First Circuit indicated that it agrees with the Seventh Circuit that "the procedural advantages conferred by registration are not substantial, at least in the context of determining the issue of likelihood of confusion." *DeCosta v. Viacom Intern., Inc.*, 981 F.2d 602 (1st Cir. 1992) (quoting *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 746 F.2d 375, 379 (7th Cir. 1984)). By agreeing with the Seventh Circuit on this issue, it is clear that these two Circuit Courts do not have conflicting views regarding the effect of the presumptions created by the registration of a trademark. The presumptions do not have a major impact on the ultimate determination of whether there is a likelihood of confusion created by an alleged infringer's use of a trademark.

2) **Second Circuit**. Whether secondary meaning has attached to a mark is a question of fact with the burden of proof on the party claiming exclusive rights. *Arrow Fastener Co., Inc. v. Stanley Works*, 59 F.3d 384, 393 (2nd Cir. 1995); *Papercutter, Inc. v. Fay's Drug Co., Inc.*, 900 F.2d 558, 564 (2nd Cir. 1990) (citing *815 Tonawanda Street Corp. v. Fay's Drug Co.*, 842 F.2d 643, 647-658 (2nd Cir. 1988)). This burden does not shift upon a decision of the USPTO to register a mark without evidence that the USPTO registered the mark upon finding that it had acquired secondary meaning. *Papercutter, Inc.*, 900 F.2d at 564. No evidence was presented to indicate that the

USPTO found the term "express" to have acquired secondary meaning. Erroneous factual findings, if any exist, do not justify review by this Court.

The ultimate test of the strength of a mark is its actual recognition among the consuming public. *Playboy Enterprises, Inc. v. Chuckleberry Pub.*, 486 F. Supp. 414, 420 (S.D.N.Y. 1980). The Third Circuit held that Express presented insufficient evidence to establish that the consuming public recognizes or identifies the "express" mark as connoting a common origin. Pet., App. A at 9a.

3) **Third Circuit.** The fact that a trade name is similar to many other businesses around the nation weakens the trade name and any minor additions or changes to that mark effectively negate any arguably confusing similarity between the two. *First Keystone Bank v. First Keystone Mortg.*, 923 F. Supp. 693, 704 (E.D.Pa. 1996). Given the fact that many businesses use the word "express," the mark "express" was held to be weak. Pet., App. E at 38a.

A claimant can establish trademark rights if it proves that consumers identify the term with the claimant, for that identification proves secondary meaning. *Dranoff-Perlstein Associates v. Sklar*, 967 F.3d 852, 855 (3rd Cir. 1992). Similarly stated, if a court finds a mark to be descriptive, the mark is legally protectable only if it has acquired secondary meaning; i.e., that consumers identify the mark as associated with a particular source of goods or services. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3rd Cir. 1986).

In its appeal to the Third Circuit, Express cited *Dranoff-Perlstein* for the proposition that Careers is required to

prove that Express' marks have not acquired secondary meaning. Nothing in *Dranoff-Perlstein* shifted that burden to Careers. Furthermore, Express claimed in its petition that the Lanham Act's presumption of distinctiveness does not shift any burden to Careers. Pet. at 17. Express first attempted, in its appeal to the Third Circuit, to have the District Court decision reversed due to an alleged shift of the burden of proof in the Third Circuit. Then Express argued in its petition that there is no shift of the burden in the Third Circuit, because such an argument could possibly be deemed to warrant a review of this case. Careers respectfully suggest that Express cannot raise arguments in its petition that it failed to present to the Third Circuit. *Equine Technologies, Inc.*, 68 F.3d at 546.

Express argued in its appeal to the Third Circuit that proof of protectability is proof of likelihood of confusion, and cited *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 465 (3rd Cir. 1983) as its authority. However, *Interpace* held that proof of likelihood of confusion is proof of secondary meaning. *Id. Interpace* did not hold that proof of protectability is proof of likelihood of confusion.

In order for Express, the owner of a legally protectable mark, to hold Careers liable for trademark infringement under the Lanham Act, Express must show that Careers has used a *confusingly* similar mark. *A & H Sportswear v. Victoria's Secret Stores*, 166 F.3d 191, 194 (3rd Cir. 1999) (emphasis added). The Third Circuit held that the plaintiff in a trademark infringement action must establish that the use of the alleged infringing mark is likely to cause confusion. *Id.* at 194. Express cannot obviate their burden of proof on the issue of likelihood of confusion based on their mere registration of several

trademarks, all of which include the descriptive term "express."

4) **Fourth Circuit.** The Fourth Circuit denied injunctive relief in an infringement action due to lack of competition in a particular geographic area, despite the fact that the phrase "Pizzeria Uno" was deemed suggestive, rather than descriptive. *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1536 (4th Cir. 1984). Despite the presumption that the phrase "Pizzeria Uno" was deemed to be suggestive, the determination that the phrase was not descriptive had no effect on the determination as to whether a likelihood of confusion was created by the alleged infringer in *Pizzeria Uno*.

The term "petro" was determined to be descriptive and weak, despite the fact that the plaintiff had eight incontestable registered marks. *Petro Stopping Centers v. James River Petroleum*, 130 F.3d 88, 92 (4th Cir. 1997). *Petro Stopping Centers* was decided after the *Pizzeria Uno* case, which was actually used in *Petro Stopping Centers* as the case that sets forth the factors to be used in the determination of likelihood of confusion. *Petro Stopping Centers*, 130 F.3d at 93 (citing *Pizzeria Uno Corp.*, 747 F.2d at 1527). The court in *Petro Stopping Centers* stated that it was free to address whether an incontestable trademark is descriptive or suggestive in determining whether the likelihood of consumer confusion exists. *Id.*, at 92. The presumption that a registered mark is not descriptive had no effect on the finding that there was no likelihood of confusion in *Petro Stopping Centers*.

5) **Fifth Circuit.** Common descriptive words make trade names weak. *Armstrong Cork Co. v. World Carpets*,

Inc., 597 F.2d 496, 505 (5th Cir. 1979) (wide usage of the mark "world" results in little likelihood of confusion); *Holiday Inns, Inc. v. Holiday Out In America*, 481 F.2d 445, 448 (5th Cir. 1973) (common word "holiday" is of weak trademark significance). "Express" is a widely used word that the District Court held had weak trademark significance. Pet., App. E at 38a. The District Court's findings clearly establish that the term "express" is descriptive regardless of which party had the burden of proof as to the issue of the distinctiveness of the term.

Furthermore, evidence of third party usage of similar marks is relevant to show that the mark is relatively weak and entitled to a narrower scope of protection. *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259-260 (5th Cir. 1980). Accordingly, the District Court held that the marks of Express are entitled to limited protection. Pet., App. E at 38a. In fact, the District Court took judicial notice of the fact that many companies use the word "express" to describe the speediness of their work. Pet., App. E at 38a.

The Fifth Circuit held that the presumption of validity that attaches to a service mark is not relevant to the issue of infringement and that the burden of proof of infringement must be borne by the party claiming injury. *Sun Banks of Fla. v. Sun Fed. Sav. & Loan*, 651 F.2d 311, 315 (5th Cir. 1981).

The Fifth Circuit also held that it would be error to grant the plaintiff a presumption of secondary meaning, because the question of secondary meaning was a question of fact to be determined by the jury. *Igloo Products Corp. v. Brantex, Inc.*, 202 F.3d 814, 818 (5th Cir. 2000).

Accordingly, there is no shift of the burden of proof as to secondary meaning in the Fifth Circuit.

6) **Sixth Circuit.** In a Michigan case it was held that it is questionable whether the term "express" is arbitrary, rather than descriptive. *Express Funding, Inc. v. Express Mortgage, Inc.*, 894 F. Supp. 1095, 1100 (E.D.Mich. 1995). Careers respectfully suggest that the District Court was correct when it found that "express" is a descriptive term. Pet., App. D at 28a. Other than the fact that Express registered its mark, there is no evidence in the record to contradict the findings of the District Court.

7) **Seventh Circuit.** The Seventh Circuit has held that the registration of a trademark does not confer upon that mark a presumption of nondescriptiveness. *EZ Loader Boat Trailers, Inc.*, 746 F.2d at 379. In *EZ Loader*, the court further stated that it did not find that the procedural advantages conferred by registration are substantial in the context of determining the likelihood of confusion. *Id.* For this reason alone, the Petition for Writ of Certiorari should be denied.

If a term is descriptive of the trademark holder's use, the holder must establish a secondary meaning in order to prove infringement. *Spraying Systems Co. v. Delavan, Inc.*, 975 F.2d 387, 393 (7th Cir. 1992). Application of the "family of marks" doctrine requires a showing that the family feature or "surname" is distinctive enough to trigger recognition "in and of itself." *Id.* at 395. In other words, a descriptive term can serve as a family surname only where there is a **strong** showing of secondary meaning in the term. *Id.* (emphasis added). The District Court held that no imagination, thought or perception is needed

to establish a connection between the term "express" and the business of Express. Pet., App. D at 27a. In addition, the District Court held that no secondary meaning has been established by Express. Pet., App. D at 28a. Express simply argued in its petition that secondary meaning should be presumed.

Validity and likelihood of confusion are distinct issues, and an incontestability finding in no way concludes the confusion question. *Source Services Corp. v. Chicagoland Jobsource, Inc.*, 643 F. Supp. 1523, 1532 (N.D.Ill. 1986). The court in *Source Services* stated that the plaintiff's argument that incontestable marks are conclusively presumed to be strong was spurious and did nothing to indicate the strength of the mark. *Id.*, at 1532-1533. Likewise, the presumption that the term "express" is a valid mark has little to do with a determination that the term "express" is a strong mark. Nor does the presumption resolve the issue as to whether the use of the term "express" by Careers causes a likelihood of confusion.

An argument that a mark is descriptive is proper to bolster a claim that there is no likelihood of confusion. *Munters Corp. v. Matsui America, Inc.*, 909 F.2d 250, 252 (7th Cir. 1990). Despite the effect of registration and the presumptions created thereby, the finding that the term "express" is descriptive is consistent with the provisions of the Lanham Act.

8) **Eighth Circuit.** In a Minnesota case, both the word "team" and the phrase "team electronics" were registered as marks with the USPTO. *Team Cent. Inc. v. Xerox Corp.*, 606 F. Supp. 1408, 1410 (1985). The word

"team" was held to lack protection as a trademark unless it acquired a secondary meaning. *Team Cent.*, 606 F. Supp. at 1413. This holding took into consideration the fact that the word "team" was registered with the USPTO. *Id.* Likewise, the registration of the word "express" by Express does not change the fact that "express" is a descriptive term. The court in *Team Cent.* further held that even if a word has acquired a secondary meaning through use in conjunction with a specific mark, others may continue to use the word in a manner that conveys its primary meaning. *Id.* Accordingly, the word "express" may be used by Careers and any other companies in a manner that conveys its primary meaning, regardless of the characterization of the term.

Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in their marks even if the goods are related. *General Mills, Inc. v. Kellogg Company*, 824 F.2d 622, 626 (8th Cir. 1987). Evidence of third party usage of similar marks is admissible and relevant to show that the mark is relatively weak and entitled to a narrower scope of protection. *Id.*, at 626-627. The District Court held that Express' marks are weak and entitled to limited protection. Pet., App. E at 38a. When the number of identical or similar trademarks already in use is high, the likelihood of confusion is low. Restatement of Torts § 729 comment g. The District Court took judicial notice that many companies use the word "express" in their names. Pet., App. E at 38a. In analyzing the similarities of sight, sound and meaning between two marks, a court

must look to the overall impression created by the marks and not compare individual features. *General Mills, Inc.*, 824 F.2d at 627. The District Court conducted such an analysis and determined that there was no likelihood of confusion between the parties' marks. Pet., App. D at 28a. Additionally, a mark's registration does not affect the plaintiff's ultimate burden of proof in an infringement action. *Id.*, at 625 (citing *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1182 n. 4 (11th Cir. 1985)).

9) **Ninth Circuit.** The strength of the phrase "Park 'N Fly" was held to not weigh heavily in favor of a finding of infringement. Nevertheless, the Ninth Circuit held that there was a likelihood of confusion between "Park 'N Fly" and "Park and Fly." *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 72 F.2d 1508, 1509 (9th Cir. 1986). Apparently, the strength of a mark is not deemed to be a decisive factor in the Ninth Circuit, regardless of any presumptions created by registration. In fact, the Ninth Circuit has held that suggestive marks are weak. *Accuride Intern., Inc. v. Accuride Corp.*, 871 F.2d 1531, 1536 (8th Cir. 1989). Even if the term "express" were to be deemed suggestive instead of descriptive, it would still be a weak term according to *Accuride*.

10) **Tenth Circuit.** Without waiving its objection to the failure of Express to address the question presented as it relates to all of the Circuit Courts, Careers will briefly address the law in the Tenth Circuit and Eleventh Circuit.

"A strong trademark is one that is rarely used by parties other than the owner of the trademark, while a

weak trademark is one that is often used by other parties." *Universal Money Centers v. AT&T*, 22 F.3d 1527, 1533 (10th Cir. 1994). The District Court found that many companies use the term "express" in the name of their businesses. Pet., App. E at 38a. Accordingly, the term "express" is weak.

The phrase "king of the mountain" was determined to be quite strong. Nevertheless, the strength of the mark was held to not outweigh the other factors, and the Tenth Circuit held that there was no likelihood of confusion. *King of the Mountain Sports v. Chrysler Corp.*, 185 F.3d 1084, 1091 (10th Cir. 1999). Accordingly, the strength of the mark is not a determinative factor.

11) **Eleventh Circuit**. The Eleventh Circuit held that it was not going to defer to an ethereal determination that is not affirmatively stated by the administrative agency. *Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991). The USPTO never affirmatively stated that the term "express" is not descriptive or that the term "express" has acquired a secondary meaning. Therefore, the aforementioned presumptions should not be applied in this case or in other trademark infringement actions.

In a Florida case, the term "final" was registered in the USPTO, but found to be a weak term due to its descriptive nature. *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F. Supp. 542, 548 (S.D.Fla. 1986). Likewise, "express" was found to be a weak term due to its descriptive nature. Pet., App. E at 38a. Again, Express failed to address the Eleventh Circuit in its petition.

Finally, the fact of registration does not affect the plaintiff's ultimate burden of proof in an infringement action. *Freedom Sav. & Loan Ass'n*, 757 F.2d at 1182 n. 4.

II. THE DECISION BELOW IS CONSISTENT WITH *PARK 'N FLY, INC. V. DOLLAR PARK AND FLY, INC.*

This Court did not hold in *Park 'N Fly* that the descriptive nature of a mark may not be considered in the separate likelihood of confusion inquiry. *Petro Stopping Centers*, 130 F.3d at 92 (citing *Park 'N Fly, Inc., v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985)). The District Court did exactly what the Fourth Circuit indicated was permissible, using the rationale of *Park 'N Fly*. Incidentally, *Petro Stopping* is a Fourth Circuit case, one which Express claims shifts the burden of proof to defendants to prove that a mark is not distinctive.

In analyzing *Park 'N Fly*, the Seventh Circuit held that it is proper to consider a mark's strength for purposes of determining if there is a likelihood of confusion. *Munters Corp.*, 909 F.2d at 252. Express is attempting to have this Court remove the strength of a registered mark as one of the factors to be used to determine likelihood of confusion, which would be inconsistent with *Park 'N Fly*.

III. THE QUESTION PRESENTED BY EXPRESS IS NOT SUFFICIENTLY IMPORTANT TO WARRANT REVIEW BY THIS COURT.

Despite the fact that trademark issues concern federal law, each circuit court uses its own set of factors to

decide whether there is a likelihood of confusion, which is the ultimate issue in all trademark infringement cases. This Court has not taken any steps to achieve uniformity among the circuit courts as to the factors to use. Nevertheless, Express is asking this Court to issue a decision to achieve uniformity among the circuit courts as to the applicability of the effect of presumptions that result from the registration of a trademark with the USPTO. Careers respectfully urge this Court to deny the petition because the finding that the term "express" is descriptive does not conflict in any way with the decisions of the other circuit courts. The findings of fact and conclusions of law of the District Court and the Third Circuit in this case clearly indicate that, despite any presumptions that may have resulted from the registration of the word "express," the term "express" is descriptive. The District Court held that the term "express" describes a characteristic of how Express provides its employment services. Pet., App. D at 26a. The District Court also held that the term "express" communicates the idea that Express provides its personnel services and career services in an expeditious manner. Pet., App. D at 27a. Even if the District Court adopted Express' position that there is a presumption created by the registration of the term "express" that the term is not descriptive, the District Court's conclusions indicate that Careers would have been found to overcome any such presumption.

Express stated in its petition that where the burden of proof lies on a given issue is frequently dispositive. Pet. at 19. However, where the burden of proof lies on the issue of the strength or distinctiveness of a mark is but one of many factors utilized to determine the ultimate

issue as to whether there is a likelihood of confusion. Again, the procedural advantages conferred by registration are not substantial in the context of determining the likelihood of confusion. *EZ Loader Boat Trailers, Inc.*, 746 F.2d at 379.

According to Express, the shift of the burden of proof on the single issue of the distinctiveness of the term "express" would automatically lead to a finding that the use of the term "express" by Careers constitutes trademark infringement, regardless of the fact that Express was unable to establish that such use created a likelihood of confusion. Pet. at 21-22. Express' argument is wholly without merit.

Careers considers it unconscionable for Express to fail to present any witnesses at trial and then argue that the issue they have presented is of critical importance in nearly every trademark infringement suit filed. Pet. at 19. In addition, Express claimed that "the allocation of the burden of proof as to a mark's distinctiveness will in virtually all but the starkest cases determine the outcome of that crucial dispute." Pet. at 19. In addition, Express actually argued in its petition that if Careers had the burden of proof as to the distinctiveness of the marks of Express, that shift would spell the difference in the outcome of this case. Pet. at 21. Such statements appear to indicate that Express believes that the burden of proof as to the ultimate issue, the likelihood of confusion, should be borne by defendants in trademark infringement litigation. If defendants in trademark infringement cases are required to disprove the distinctiveness of a trademark, those defendants would be forced to disprove the likelihood of confusion according to the arguments of Express.

Such propositions are contradictory to all trademark laws and due process.

CONCLUSION

Regardless of the assertion by Express that defendants in trademark infringement actions should have the burden of proof on the issue of the distinctiveness of a registered term, the term "express" is descriptive based on the findings of the District Court and the Court of Appeals. The determination that the term "express" is descriptive does not conflict with any of the cases cited by Express in its petition. Nor is the decision in this case based on an issue that is sufficiently important to warrant review by this Court. Express' attempt to shift the burden of proof as to one of the multiple factors used to assess the likelihood of confusion is not sufficient for the grant of a writ of certiorari.

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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